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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

SINGH, SATWANT K

ART UNIT	PAPER NUMBER
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2626

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DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/925,651

Applicant(s)

PARRY, TRAVIS J.

Examiner

Satwant K. Singh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/925,650. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter as follows:

Receiving data at a printer; detecting an external address in the received data; retrieving the document from the external address; and printing the document.

Claim 1 in the copending application fails to disclose the parameters to be met by the document at the external network address. However, claim 1 of the copending application discusses determining whether a URL or external network option is enabled.

The step of enabling/disabling of the URL or external network option is accomplished by the use of predetermined criteria. The predetermined criteria are described as whether the URL meets a security requirement, such as a password, or whether it has antivirus protection. **[Paragraph 0036]**

The instant application describes the parameters to be met as whether the document is subject to security procedures such as virus protection, etc. **[Paragraph 0037]**

Therefore, it would be obvious to one having ordinary skill in the art that these limitations are variations of each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claim 2 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of copending Application No. 09/925,650. The conflicting claims are identical.

4. Claim 3 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of copending Application No. 09/925,650. The conflicting claims are identical.

5. Claims 5-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending

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Application No. 09/925,650. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter as follows:

The criteria/parameters described in claims 5-19 are obvious variations of the criteria described in the copending application

6. Claim 20 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 22 of copending Application No. 09/925,650. Claim 20 is rejected for the same reason as claim 1.

7. Claim 21 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/925,650. Even though a specific claim does not exist in the copending application describing a system comprising the steps in claim 21, it would be obvious to one having ordinary art in the skill that since print stream data is being applied to the method described in claim 1 **[Paragraph 0030]**, a system comprising the steps in claim 21 is being described. Claim 21 is rejected for the same reason as claim 1.

Claim Objections

8. Claims 10-13 are objected to because of the following informalities: These claims are dependent on claim 8. It appears to the examiner that the claims should be dependent on claim 9. Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. Claims 10-11 recite the limitation "the option" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

10. Claims 12-13 recite the limitation "the prompting the user step" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

11. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the examiner where the print authorization is occurring.

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The terminology "machine readable code" alone has no set definition. A statutory product with descriptive material must include a positive recitation of the computer readable medium. See MPEP § 2106. Appropriate

correction is required.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

14. Claims 1, 2, 3, 6, 8, 20 and 21 are rejected under 35 U.S.C. 102(a) as being anticipated by Marx (US 6,348,970).

Regarding claims 1 and 3, Marx discloses an apparatus and method for interfacing a facsimile machine with a computer network (Abstract, lines 1-2). a printing method comprising the steps of receiving data at a printer (reads on fax machine) (col. 4 lines 51-54); detecting an external network address (reads on URL) (col. 4, lines 41-46); determining if at least one parameter meets a predetermined first criteria (reads on if the identified difference corresponds with a URL symbol) (col. 11 lines 31 – 36); if at least one parameter meets the first criteria, then retrieving the document from the external network address (reads server retrieves the corresponding document) (col. 11, lines 31-36); and printing the document (reads on the control page is then transmitted to the fax machine) (col. 11, lines 34-36).

Regarding claim 2, Marx discloses that identifying information can take various printed forms, including barcodes. The detecting an external network address step

(reads on URL) comprises detecting a barcode in the received data and translating the barcode to the external network address. (col. 6, lines 12-15 and 22-23).

Regarding claim 6, Marx discloses a printing method, wherein the first criteria is that the document is available (reads on if the identified difference corresponds with a URL symbol) (col. 11 lines 31 – 36).

Regarding claim 8, Marx discloses a printing method, wherein if the at least one parameter does not meet the first criteria, then not retrieving the document from the external network address (reads on transmitted control page indicating error condition) (col. 11, lines 44-52).

Claims 20 and 21, as best understood from the language of the claims are rejected for the same reasons as claim 1

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 4, 7, 9-11, and 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marx (US 6,348,970) in view of Kanoh et al (US 5,873,077). Marx discloses control pages (user and transmitted) with identifying information, control symbols, URL symbols, and skew indicators (col. 6, lines 13-15).

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Regarding claims 4, 7, and 19, Marx does not specifically disclose the first and second criteria (identifying information) as listed in the claims. Kanoh et al disclose a system for searching and retrieving documents using a facsimile machine by filling out search terms or search parameters (col. 4, lines 18-30). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Marx by the teaching of Kanoh to add the criteria to be the search terms or search parameters in order to increase the types of identifying information on the user control page as disclosed by Marx.

Regarding claims 9-11, Marx fails to disclose alternate options if at least one parameter does not meet the first criteria. Kanoh et al disclose a system for modifying the search if the search fails (col. 9 lines 38-40). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Marx by the teaching of Kanoh to add the alternate options to the transmitted control page indicating an error condition as disclosed by Marx.

Regarding claims 14-18, Marx fails to disclose a modified document retrieval. Kanoh et al disclose a system where a system retrieves URLs and other information corresponding to matching documents. This other information includes but is not limited to abstracts, document length, format, etc (col. 9, lines 4-6). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Marx by the teaching of Kanoh to add the other information as an alternate options to the transmitted control page indicating an error condition as disclosed by Marx.

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17. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marx (US 6,348,970) in view of Dutta (US 2002/0065910).

Marx differs from claim 5 in that he does not clearly disclose retrieving data based on download time. Dutta discloses a method for rendering network addresses of files capable of being downloaded over a network onto a printer (reads on output device). A rating is associated with each network address indicating a relative time to access a file from the network address. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Marx by the teaching of Dutta by adding download time as identifying information on the user control page in order to increase the types of identifying information disclosed by Marx.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satwant K. Singh whose telephone number is (703) 306-3430. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Satwant Singh

Satwant K. Singh
Examiner
Art Unit 2626



MARK WALLERSON
PRIMARY EXAMINER